

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 3-4, 6, 8-13, 15-18, 20-23, 25-26, 28, 30-31, 33-35, 37-39 and 41-43 remain active in the application.

Claim Rejections Based on 35 U.S.C. § 103

Claims 1, 3-4, 6, 8-13, 18, 20-23, 25-26, 28, 30-31, 33-35, 39 and 41-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karaoguz et al (U.S. Publication No. 2004/0029621) (Karaoguz) in view of Rudis. Claims 15-17 and 37-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karaoguz in view of Rudis and Pacchiano. Applicant respectfully traverses these rejections on the grounds that the combination of references fails to teach all limitations of any rejected claim, and therefore fails to present a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach all limitations of the rejected claims. Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims.

Rejection of Claims Based on Karaoguz and Rudis

Claims 1, 3-4, 6, 8-13, 18, 20-23, 25-26, 28, 30-31, 33-35, 39 and 41-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karaoguz in view of Rudis. Applicant

respectfully traverses this rejection on the grounds that the combination of references fails to teach all limitations of any rejected claim, and therefore fails to present a *prima facie* case of obviousness.

Amended claim 1 requires "powering up a wireless section of an IHS to detect a presence of a wireless network while a system processor remains in a reduced power state; and providing an indication to a user that a wireless network is present with which the IHS can communicate."

Claim 1 includes "powering up a wireless section of an IHS to detect a presence of a wireless network while a system processor remains in a reduced power state." Karaoguz does not teach powering up a wireless section of an IHS to detect a presence of a wireless network while a system processor remains in a reduced power state. What Karaoguz actually teaches is a system processor that is powered up to generate power level control commands for different elements of the IHS. According to Karaoguz, "processor module 50 generates power level control commands 110 for each power delivery element to prompt it to provide full power, reduced power or no power, to its corresponding transceiver element 104 or application element 106." Figure 3; Paragraph [0048]. As such, if a transceiver element is turned on and all application elements are turned off, the processor module still must function in order to send power level control commands to the power delivery element corresponding to the transceiver element that is turned on.

Rudis teaches nothing to overcome the deficiencies of Karaoguz. For at least this reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1. Independent claim 23 is patentable at least for similar reasons as described for representative claim 1.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1 and 23, and to the claims which depend therefrom.

With respect to dependent claims 6 and 28, those claims are further patentable due to the powering up the wireless section prior to booting the IHS, which is neither taught nor suggested by the prior art references.

With respect to dependent claims 8 and 30, those claims are further patentable due to the actuating a scan switch to commence powering up the wireless section, which is neither taught nor suggested by the prior art references.

With respect to dependent claim 9, this claim is further patentable due to the powering up the wireless section in response to a wake command, which is neither taught nor suggested by the prior art references.

Rejection of Claims Based on Karaoguz and Rudis and Pacchiano

Claims 15-17 and 37-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karaoguz in view of Rudis and Pacchiano. Applicant respectfully traverses this rejection on the grounds that the combination of references fails to teach all limitations of any rejected claim, and therefore fails to present a *prima facie* case of obviousness.

As discussed above, Karaoguz and Rudis fail to teach certain limitations of claims 1 and 23, from which claims 15-17 and 37-38 depend. Pacchiano teaches nothing to overcome the deficiencies noted for the combination of Karaoguz and Rudis. Applicant thus submits that the combination of references fails to teach all limitations of any rejected claim. Accordingly, Applicant respectfully requests withdrawal of this rejection.

With respect to dependent claims 15 and 37, those claims are further patentable due to the storing profile information in a memory accessible to the wireless section while the system processor remains in the reduced power state, which is neither taught nor suggested by the prior art references.

With respect to dependent claims 17 and 38, those claims are further patentable due to the determining if a detected network matches a network included in a profile stored in the memory accessible to the wireless section while the system processor remains in the reduced power state, which is neither taught nor suggested by the prior art references.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because the combination does not teach or suggest all limitations of the rejected claims.

Thus, none of these references provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)


In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims.

Conclusion

In view of all of the above, the allowance of claims 1, 3-4, 6, 8-13, 15-18, 20-23, 25-26, 28, 30-31, 33-35, 37-39 and 41-43 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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